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10/728,219

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Brian John Roberts

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K&L GATES LLP  
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EXAMINER

LEIVA, FRANK M

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/728,219	<b>Applicant(s)</b> ROBERTS, BRIAN JOHN	
	<b>Examiner</b> FRANK M. LEIVA	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-39,43-55,60 and 61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-39,43-55,60 and 61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 January 2009 has been entered.

### ***Acknowledgements***

2. The examiner acknowledges amendments to claims 27, 31 and 48, and new claims 60 and 61 in applicant's submission filed 12 January 2009.

### ***Response to Arguments***

3. Applicant's arguments filed 12 January 2009 regarding claims 27-28, 32-38, 43-55 and 60-61 have been fully considered but they are not persuasive. Persuasiveness considerations as follows;

4. To the argument on page 8 of applicant's remarks regarding restrictions to claims 57-59; *"The Office Action's characterization of the claims is not correct. The interactive game recited in claim 48 is not limited to a lottery game"*, claim 48 reads *"A method of conducting a lottery"*; interactive game aside, the method is a lottery with a secondary (or bonus) video game, not included is the capability of the game to be a skill game. The definition of lottery precludes the notion of skill involved, the outcome must be a matter of chance only.

5. Regarding the argument on page 8 of applicant's remarks in regards to claims 27 and 48; *"The instant lottery ticket can also be purchased without activating this feature. In contrast, Kaye does not teach or suggest such a hybrid ticket, or any game or game ticket dispenser with this feature"*, Roberts figs. 2 and 7 demonstrate that the lottery tickets can be played with or without the secondary game as shown in the description of figure 7 column 6 lines 41-65. Fig. 2A shows the "rub off" material while other tickets in fig. 7 do not, and also they

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are not mutually exclusive embodiments, a single dispenser may sell tickets for both games.

6. Regarding the argument on page 9-10 of applicant's remarks in regards to claim 27; *"Roberts does not teach or suggest an interactive game played using a computing device, a ticket which is used in the play of such a game, let alone such a game which is played "based at least in part on the interactive game information" provided on such a ticket. Moreover, what the Office Action characterizes as Roberts "interactive game" is in fact not an "interactive game" but merely a scratch-off lottery game"*, in the rejection of claim 27 Roberts is not used to show interactive game nor a computing device, both does limitations are covered by Kaye and need not be repeated on a second reference.

7. Regarding the argument on page 10 of applicant's remarks in regards to claim 27; *"Applicant has added a recitation to claim 27 that expressly recites the computing device is configured to provide access to the interactive game responsive to an indication of whether the lottery ticket was activated to provide access to the interactive game. This feature is not in Kaye, and is not provided by Roberts, which has nothing to do with computer-based interactive games whatsoever"*, the examiner reminds the applicant of Kaye's title "Personal Computer Lottery game" is all about a computing device that displays and interactive game.

8. Regarding the argument on page 10 of applicant's remarks in regards to claim 28; *"Separately and independently with respect to claim 28, neither Kaye nor Roberts teach or suggest printing interactive game information on an instant win lottery ticket responsive to an indication the player has chosen to purchase the instant win lottery ticket for use in an interactive game"*, the examiner points to Kaye fig. 13 item 252 "print out a ticket with encrypted control data", and Roberts column 4 lines 1-4, "The terminal 14 includes a printer 19 which then prints the computer 18 supplied "play data" and ticket completion information. Both references disclose printing game information indicative of the purchase of the ticket.

9. Regarding the argument on page 10 of applicant's remarks in regards to claim 28; *"Separately and independently, with respect to claim 29, neither Kaye nor Roberts teach or suggest a reader **in the ticket dispenser** configured to read the ticket identifier from the lottery ticket prior to the ticket being activated for use in the interactive game. The Office Action cites Kaye 453-61, where tickets are read by an amusement game terminal, but this reading occurs only after tickets have been dispensed*

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*and activated for use in the interactive game, not before, and not by the ticket dispenser. Therefore claim 29 should be allowable for at least this additional reason*", the examiner points to Roberts column 4 lines 7-21, where the player selects a card and is read by the printing/dispensing device previous to printing the activation code on the card.

**10.** Regarding the argument on page 12 of applicant's remarks in regards to claim 55 and 56; "*Separately and independently from the arguments made above for its parent claim, claim 55 recites 'providing the interactive game information on the removable covering'. e.g. on a peel off or pull off layer concealing the instant game information.*", the examiner points that the only limitation covered by Mullins for the rejection is the stated information printed on the removable covering and as applied in the arguments above all other limitations are covered by Kaye and Roberts, the known technique of Mullins is applied to Kaye and Roberts that already admit to five different ways of winning and one more would not be un-obvious.

**11.** Regarding the argument on page 13 of applicant's remarks in regards to claims 60-61; the examiner finds that since the current action deems claims 27 and 48 not allowable, that claims 60 and 61 will be covered in the action below.

**12.** Applicant's arguments, see remarks, filed 12 January 2009, with respect to the rejection(s) of **claim(s) 29-31** under 35 USC § 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, same ground of rejection is made in view of already of record Roberts.

**13.** Applicant's arguments, see remarks, filed 12 January 2009, with respect to the rejection of **claim 39** under 35 USC § 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Walker et al. (US 6,497,408 B1).

### ***Claim Rejections - 35 USC § 103***

**14.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**15. Claims 27 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye (US 5,569,082), in view of Roberts (US 5,772,510).**

**16. Regarding claims 27 and 48; Kaye discloses:**

A lottery gaming system, comprising: a lottery ticket, the lottery ticket including a ticket identifier, an interactive game information, and an instant game information, and a removable covering concealing the instant game information, (col. 1:25-35).

A lottery ticket dispenser configured to dispense the lottery ticket, (col. 4:40-52).

The lottery ticket dispenser configured, responsive to receiving the input indicating the player's choice to purchase the lottery ticket, (col. 4:40-52), without activating the lottery ticket for use in the interactive game, to dispense the lottery ticket without activating the lottery ticket for use in the interactive game, (col. 7:45-54; where a player may choose on a menu to play either a simple "lotto" game or an interactive "horses game" using a lottery ticket).

A central computer system in communication with the lottery ticket dispenser and configured to receive from the lottery ticket dispenser an indication that the player has chosen to purchase the lottery ticket for use in the interactive game, the central computer system configured to, responsive to the receipt of the indication, to activate the lottery ticket for use in the interactive game, (col. 4:40-52; where a central single computer network controls lottery information and distribution), and a computing device remote from and in communication with the central computer system, the computing device configured to receive the interactive game information from the lottery ticket, the computing device further configured to be utilized by the player to play the interactive game based at least in part on the interactive game information, (col. 3:4-12).

Kaye fails to disclose games without the features of his invention (destiny bonus), yet shows the ability of the player to choose among a selection of different games.

Roberts discloses: A lottery ticket dispenser configured to dispense the lottery ticket, the lottery ticket dispenser including an input device configured to receive, prior to the lottery ticket being dispensed, an input indicating a player's choice between purchasing the lottery ticket as a hybrid instant lottery ticket that is also usable in an interactive game and purchasing the lottery ticket without activating the lottery ticket for use in the interactive game, (fig. 7 and description; whereas the dispenser contains games that are scratch off and games that are not).

**17. Regarding claims 27 and 48;** It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the vending machine style of Roberts to the Kaye invention to reach more types of gamblers and combined them into a single system as an application of well known dispensing apparatuses.

**18. Regarding claims 28 and 50,** Kaye discloses a lottery gaming system wherein the lottery ticket dispenser includes a printer configured to print the interactive game information on the lottery ticket responsive to the indication that the player has chosen to purchase the lottery ticket for use in the interactive game (col. 3:4–12).

**19. Regarding claims 29 and 49;** Kaye and Roberts disclose all the limitations of claims 27 and 48 from which claims 29 and 49 depend on; and Roberts further discloses a lottery game system wherein the lottery ticket is pre-printed with the interactive game information, the ticket dispenser including a reader configured to read the ticket identifier from the lottery ticket prior to the ticket being activated for use in the interactive game, (col. 4:7-21), wherein the preprinted barcode is read by the dispenser previous to printing the activation information on the selected card. Since Roberts uses a scanner to identify the type of card being purchased it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the

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scanner in the Kaye/Roberts combination already made above in claim 27. It would be required to identify the type of card before printing.

**20. Regarding claim 30,** Kaye and Roberts disclose all the limitations of claims 27 and 29 from which claim 30 depends on; and Roberts further discloses a lottery game system, wherein the reader is configured to read the ticket identifier from the lottery ticket prior to the lottery ticket being dispensed, (col. 4:7-21), wherein the preprinted barcode is read by the dispenser previous to printing the activation information on the selected card. Since Roberts uses a scanner to identify the type of card being purchased it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the scanner in the Kaye/Roberts combination already made above in claim 27. It would be required to identify the type of card before printing.

**21. Regarding claims 31 and 51,** Kaye and Roberts disclose all the limitations of claims 27, 29 and 48 from which claims 31 and 51 depend on; and Roberts further discloses a lottery game system, wherein the ticket dispenser is further configured to communicate the ticket identifier read from the lottery ticket to the central computer, (col. 4:7-21), wherein the preprinted barcode is read by the dispenser previous to printing the activation information on the selected card. Since Roberts uses a scanner to identify the type of card being purchased it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the scanner in the Kaye/Roberts combination already made above in claim 27. It would be required to identify the type of card before printing.

**22. Regarding claims 32 and 53,** Kaye discloses a lottery game system wherein the ticket identifier and interactive game information are encoded in a bar code (col. 2:55–58; col. 3:7–12; where a bar code is a type of symbolic encryption that may be used to encrypt destiny codes that may be stored on a paper medium).



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**23. Regarding claim 33**, Kaye discloses a lottery game system wherein the ticket identifier and interactive game information are separate and apart on the ticket (col. 7:20–24; where interactive game information is stored in a destiny code and a ticket identification serial number history is stored in a separate location).

**24. Regarding claim 34**, Kaye discloses a lottery gaming system wherein the interactive game information includes an access code configured to permit the player to access the interactive game (col. 3:23–25).

**25. Regarding claims 35 – 36**, Kaye discloses a lottery gaming system wherein the computing device is in communication with the central computer system via the Internet and the interactive game information includes an Internet address where the player can access the interactive game (col. 9:1–3; where an on-line component for games is used, which may include the Internet).

**26. Regarding claim 37**, Kaye discloses a lottery gaming system wherein the computing device is remote from the lottery ticket dispenser (col. 3:4–15; col. 4:53–61).

**27. Regarding claims 43 – 44**, Kaye discloses a lottery gaming system wherein the interactive game information is pre-printed on the lottery ticket and activated in response to a transmission of the identifier to the central computer system (col. 3:23–25) and the central computer system is further configured to transmit the interactive game information to the ticket dispenser and wherein the ticket dispenser is configured, responsive to the receipt of the interactive game information from the central computer, to print the interactive game information on the game ticket (col. 6:1–6).

**28. Regarding claims 45 – 46**, Kaye discloses a lottery gaming system wherein the removable covering is a scratch-off layer and wherein the removable covering includes the interactive game information (col. 1:25–32; where a removable covering includes game information).

**29. Regarding claim 52**, Kaye discloses a method wherein the activating the lottery ticket occurs prior to providing the player the lottery ticket (col. 3:16–45; where a destiny code is generated and activated by a dispenser before it is given to a player, and later verified for use in an interactive game).

**30. Regarding claim 54**, Kaye discloses a method including crediting an account of the player if the player wins the interactive game (col. 8:48–61).

**31. Regarding claim 38**, Kaye discloses a lottery gaming system wherein the computing device is remote from the lottery ticket dispenser (col. 3:4–15; col. 4:53–61), but does not disclose that the computing device is incorporated into the lottery ticket dispenser. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the game system using separate lottery dispensing and player terminals of Kaye with an integrated lottery dispensing and player terminal in order to increase convenience for a player by providing all elements of a gaming system in one location.

**32. Regarding claim 47**, Kaye and Roberts disclose all the limitations of claim 27 from which claim 47 depends on; and Roberts further discloses a lottery ticket, but does not disclose a specific method of storing lottery tickets. However, Roberts teaches a lottery ticket wherein the lottery ticket is releasably coupled by lines of weakness to additional lottery tickets in a fan fold stack of lottery tickets (col. 3:29–30), in order to organize tickets for dispensing. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the lottery and interactive game system using tickets of Kaye with the fan folded tickets of Roberts in order to better organize tickets for dispensing.

**33. Regarding claims 60 and 61**, Kaye and Roberts disclose all the limitations of claims 27 and 47 from which claims 60 and 61 depend on; and Kaye further discloses

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wherein the computing device is further configured, responsive to receipt of an indication that the lottery ticket has not been activated for use in the interactive game, to prevent the player from playing the interactive game using the lottery ticket, (col. 6:45-47).

**34. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye, as applied to claims above in view of Walker et al. (US 6,497,408 B1).**

**35. Regarding claim 39**, Kaye discloses a lottery gaming system, with a computing device, but does not disclose a portable device. Walker discloses the computing device can be a handheld device, (Col. 5:1-8 and 22-25). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention after reading Walker's disclosure, to enhance the player interface device by making it portable and handheld. Using the known technique of handheld lottery consoles of Walker, to substitute for the personal computer lottery of Kaye would have been an obvious predictable result to one of ordinary skill.

**36. Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye as applied to claim 48 above, and further in view of Mullins (US 5,158,293).**

**37. Regarding claim 55 and 56; Kaye and Roberts disclose** all the limitations recited in claim 48 from which claims 55 and 56 depend on, although Kaye is silent about continuing the game after an instant win. Mullins discloses providing the interactive game information on the removable covering; after the removable covering has been removed by the player, receiving a tender of the lottery ticket without the removable covering for a prize in the instant win game; responsive to receiving the tender of the lottery ticket, redeeming the lottery ticket for a the prize in the instant win game; and providing the interactive game play to the player at the computing device after the player has redeemed the lottery ticket for a prize in the instant win game; the

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receiving at least a portion of the interactive game information from the ticket at the computing device occurs after the tender of the lottery ticket, the interactive game information being provided by the player from removable covering, (abstract, col. 2:25-63; in which Mullins covers a lottery ticket with a redeemable instant win and keeping the remainder of the ticket for accumulation of letters for the progressive win). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the very well known method of Mullins in the Kaye and Roberts invention to introduce yet another winning level in the game. These features are not novel but very well known methods of entertainment in the lottery arts, which yield a predictable result.

**38. Examiner's Note:** Examiner has cited paragraphs and figures in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

**39.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571)272-2460. The examiner can normally be reached on M-Th 9:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML

05/28/2009.

/Peter D. Vo/

Supervisory Patent Examiner, Art Unit 3714